

Application No.: 09/372,416

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**REMARKS / ARGUMENTS**

This Reply is in response to the Office Action mailed April 2, 2012.

**I. Request for Interview**

In the event the following remarks fail to place this application in condition for allowance, Applicant respectfully requests the opportunity to interview with the Examiner at her convenience, and prior to the issuance of a subsequent Office Action, to assist in expediting prosecution.

**II. Status of Claims**

Claims 18-84 are pending in this application. Claim 18 is withdrawn from consideration. Claims 19-84 stand rejected. Claims 19 and 52 are presently amended.

**III. Rejection under 35 U.S.C. § 112, ¶ 2**

The Office Action rejected claims 19-84 under 35 U.S.C. § 112 ¶ 2, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action notes that the limitation in independent claims 19 and 52, "the each set of bidding parameters including specifications of advertising opportunities, wherein the associated advertiser desires, whereby the each set of bidding parameters indicates whether the associated advertiser is desirous that a bid should be submitted" is unclear and also lacks antecedent basis. The aforesaid limitation in claims 19 and 52 is being clarified with the present amendment. The rejection under § 112 ¶ 2 is thus believed to have been obviated.

**IV. Provisional non-statutory double patenting rejection**

The Office Action provisionally rejected claims 19 and 52 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/933,080 in view of Robinson, U.S. Pat. No. 5,918,014 (hereinafter "Robinson").

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The Office Action further provisionally rejected claims 20-51 and 53-84 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/933,080 in view of Robinson as applied to claims 19 and 52 and in further view of Goldhaber et al., U.S. Pat. No. 5,794,210 (hereinafter "Goldhaber").

The Office Action further provisionally rejected claims 19 and 52 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/933,122 in view of Robinson.

The Office Action further provisionally rejected claims 20-51 and 53-84 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/933,122 in view of Robinson as applied to claims 19 and 52 in further view of Goldhaber.

The Office Action further provisionally rejected claims 19 and 52 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Reissue Application No. 10/655,549 in view of Robinson.

The Office Action further provisionally rejected claims 20-51 and 53-84 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/655,549 in view of Robinson as applied to claims 19 and 52 in further view of Goldhaber.

Applicant respectfully traverses the rejections. As stated in M.P.E.P § 804

[A] 'provisional' double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that 'provisional' double patenting rejection is the only rejection remaining in at least one of the applications....[i]f a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

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Applicant respectfully submits that all other grounds of rejection are overcome with the present amendment and reply. Accordingly, withdrawal of the provisional double patenting rejections is respectfully requested.

**V. Rejection under 35 U.S.C. § 103(a) over Goldhaber et al. in view of Robinson**

The Office Action rejected claims 19-84 under 35 U.S.C. §103(a) as being unpatentable over Goldhaber in view of Robinson.

Applicant respectfully traverses the rejection for the reasons stated below.

It is well-settled law that obviousness requires at least a suggestion of all of the features in a claim. *See In re Wada and Murphy, citing CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). The necessary presence of all claim features is axiomatic, as the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including . . . ascertaining the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Accordingly, the failure of an asserted combination to teach or suggest each and every feature of a claim is fatal to an obviousness rejection under 35 U.S.C. § 103.

Section 2143.03 of the M.P.E.P. requires the “consideration” of every claim feature in an obviousness determination. To render claim 19 unpatentable, however, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest each and every claim feature. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). A proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention — *including all its limitations* — with the teaching of the prior art.” *See In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original).

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**The claimed invention**

Claim 19, as amended, provides as follows:

A method implemented in a computer system of one or more networked computers, for determining in response to an advertising opportunity, which advertisement of a plurality of advertisements to provide for fulfilling the advertising opportunity, the advertising opportunity being an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the method comprising:

- maintaining in the computer system a plurality of sets of bidding parameters, each set of bidding parameters being associated with at least one of the plurality of advertisements, the each set of bidding parameters including specifications of advertising opportunities, wherein the each set of bidding parameters indicates whether a bid should be submitted for providing one of the associated at least one of the plurality of advertisements for fulfilling the advertising opportunity, wherein at least one of the plurality of sets of bidding parameters specifies a web page characteristic;

- receiving in the computer system an indication of the request for content, thereby presenting the advertising opportunity; and in response to the request for content:

- submitting in the computer system one or more bids, each submitted bid being based on one of the sets of bidding parameters, the one of the sets of bidding parameters being met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs;

- selecting in the computer system a bid from among the submitted bids;
  - and

- serving by the computer system to the browser an advertisement associated with the selected bid,

- whereby the served advertisement is determined by a bidding process.

The claimed invention provides a mechanism for bidding for an advertising opportunity, the selection of a bid, and the display of a corresponding advertisement **in real time** – that is **in response to a request for content** received from a browser.

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When a viewer initiates an HTTP request such as by clicking on link in a web page to access a web page, the process of the selection of the bid and the corresponding advertisement occurs in real time.

The specification at ¶ 0032 explains the power of the claimed invention with reference to a preferred embodiment thereof as follows:

[0032] In order to understand the power of the system shown in Figures 1 and 2, it is important to realize that the bidding agents 30 evaluate proposed bids in microseconds, that is, in real time. The rate at which "hits" on web pages occur (i.e. the rate at which viewers access web pages that have HTML reference to server system 16) can be in the order of thousands per second. Thus, the evaluation of proposed bids is performed very quickly in real time. Proposed bids can contain parameters which specify that a proposed bid will in effect change in real time. For example a proposed bid might specify that for the first 1000 matching view-ops, the proposed bid will be five cents and for the next 1000 matching view-ops the proposed bid will be four cents. The actual submission of proposed bids by advertisers and the rate at which advertisers can change their proposed bids is measured in minutes compared to the rate at which the system evaluates proposed bids which is in the order of microseconds.

The real time mechanism is set forth in Claim 19 as follows:

*receiving in the computer system an indication of the request for content, thereby presenting the advertising opportunity;*

*and in response to the request for content:*

*submitting...*

*selecting...and*

*serving...*

As seen, the steps of *determining, selecting and identifying* all occur in *response to the request for content...*

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**The teaching of Goldhaber**

Goldhaber teaches a system and method that compensates users for viewing advertisements. When a user logs on to his personal homepage, the user is shown a list of preselected advertisements that are targeted to the user's interest. Col. 7 lines 27-32. A virtual price tag is associated with each advertisement that indicates the amount the user will receive for viewing the advertisement. Each time the user selects an advertisement for further viewing, the user is compensated in the form of digital cash according to the price tag associated with the advertisement. The digital cash is credited to the user's account. Fig. 3, col. 10, lines 39-66.

In pertinent part, Goldhaber states the following:

Upon logging on to her customized home page, Cynthia would be presented with a list of ads that she may elect to view. The ads would be preselected for her on the basis of a personal profile questionnaire that she has completed plus automatic tracking of her previous Internet usage. For example, today's list might contain ads for medium-price hotels in Mazatlan (where Cynthia is planning a vacation), a do-it-yourself telescope kit (a possibility for her son's upcoming birthday), San Francisco Forty-Niner football tickets (she's a fan), new nonfat organic dessert items (she's on a diet), and heavy equipment for earth moving (she is part-owner of a construction company). (emphasis added.)

Goldhaber col. 7, lines 27-35.

In Goldhaber, the users are presented with preselected advertisements together with associated price tags. Unlike the claimed invention, Goldhaber does not disclose a real-time bidding and selection mechanism in response to requests for content.

Additionally, Goldhaber (at col. 4 lines 47-63) describes an auction mechanism through which advertisers can competitively bid for a viewer's attention. The passage in Goldhaber is reproduced as follows:

"Negative pricing" is one means by which advertisers could compete for available attention in the system provided in accordance with the present invention. In its simplest form, negative pricing is a "passive" competition:

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advertisers make fixed offers and viewers select among them. Another innovative idea is "attention bidding," a mechanism by which advertisers actively compete by bidding for a viewer's attention. These bids might be based, in part, on estimates of the viewer's interest and likelihood to buy--estimates derived from access to the viewer's electronic profiles detailing preferences and past consuming behavior. Bids might also be based on other bids, via an "auction" protocol by empowered bidding "agents." The bidding may be explicit or automatic. Viewers may elect to have advertisers bid for their attention or the system may offer bidding without the viewers' knowledge.

Goldhaber at Col. 4, lines 47-63.

The foregoing passage is the only instant where Goldhaber describes an auction mechanism. Other than the foregoing passage, Goldhaber does not elaborate on how the auction mechanism works. Critical aspects of the auction mechanism disclosed in this passage are unclear. The auction mechanism in Goldhaber may provide advertisers flexibility in pricing their respective advertisements. For example, instead of each advertisement being associated with a fixed amount (e.g. \$1.00), the advertisers competitively bid between themselves and the user is presented with different amounts associated with different advertisements based on competitive bidding (e.g., advertisement A may be worth \$0.75 while advertisement B may be worth \$1.00, etc.) The system does not select among the different advertisements based on the bids. Rather, when the user is shown all advertisements relevant to the user's interest, it is the user that may then select among the advertisements and is compensated in accordance with the bid amounts.

Indeed, the above-quoted passage does not disclose "selecting" a bid by the auction system as required in claim 19.

Goldhaber does not disclose an auction mechanism whereby advertiser bid in real time to fulfill an advertising opportunity in response to a request for content by a browser, and the selection of winning bid occurs in real time.

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In contrast, the invention of the present application as claimed provides for a real-time bidding system. The system selects among bidding advertisers in real-time based on a competitive bidding mechanism that occurs at the time a viewer requests a web page.

The Office Action relies on Robinson for disclosing "*wherein at least one of the plurality of sets of bidding parameters specifies a web page characteristic*". However, the Office Action relies on Goldhaber for disclosure of all other steps recited in claim 19. Yet as respectfully noted, however, Goldhaber fails to disclose these steps.

The rejection of claims 20-84 are is traversed for the same reasons set forth above with respect to claim 19.

Accordingly, it is respectfully submitted that claim 19-84 are not unpatentable over Goldhaber in view of Robinson. Withdrawal of the rejection is respectfully requested.

#### VI. Related Applications

Applicant respectfully would like to draw the attention of the Examiner to the following related applications for claimed inventions of similar subject matter and disclosures corresponding to the disclosure of this application. These applications claim priority to Application No. 08/787,979 (the grandparent of this application) and include the following: 10/655,549, 11/675,429, 09/216,206, 09/927,981, 11/933,122, 11/933,080, and 11/926,939. The Examiner is respectfully requested to consider the prosecution history of the aforementioned applications as available through the Office's Image File Wrapper system, and to determine as necessary its relevance to the present application.



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CONCLUSION

In view of the above remarks, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and reconsideration thereof is respectfully requested. The Examiner is respectfully requested to telephone the undersigned if she can assist in any way in expediting issuance of a patent.

Dated: September 30, 2012

Respectfully submitted,

/Benzion A. Wachsman/

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\*A statement under 37 CFR § 3.73(b) is attached

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